

### III. REMARKS

1. Claims 25-39 are new. Claims 11-39 are pending in this Application.
2. Applicant appreciates the Examiner's indication of allowable subject matter in claims 19-24. New claim 25 represents claim 19 amended to include the subject matter of the claims from which it depends. Accordingly, claims 25-30 should be allowable.
3. Claim 31 represents a combination of claims 11, 12 15 and 16. For the reasons set forth below, claims 31-39 should also be allowable
4. It is respectfully submitted that claims 11 and 12 are patentable under 35 U.S.C. §102(b) over Martensson, U.S. Patent No. 5,151,946. Claim 11 recites, a first body portion comprising first and second grooves, a keypad, and a second body portion comprising first and second runners, the first and second runners being positioned in the first and second grooves respectively to allow the second body portion to slide longitudinally relative to the first body portion between a closed position in which the keypad is concealed and an open position in which the keypad is exposed, the first body portion further comprising a first detent located in the first groove, and the second body portion further comprising a first recess in the first runner to hold the second body portion relative to the first body portion when the first recess coincides with the first detent. Martensson does not disclose or suggest these features.

Martensson discloses a hand portable cellular radio telephone that has a housing (1) having a main body (2) enclosing substantially the whole of the electronic circuitry of the

telephone (Col. 3, L. 33-37). The housing (1) has a sleeve-like portion (7) slidably mounted on the main body (2) (Col. 3, L. 53-54). The sleeve (7) fits snugly round the main body (2) of the housing (1) such that only relatively gentle pressure is required to slide the sleeve relative to the main body (2). The sleeve (7) may simply bear against the main body (2) or additional bearing members may be incorporated to improve the sliding action. An outwardly biased leaf spring (not shown) may be fastened to each side of the main body (2) so that the sleeve bears against the leaf spring surfaces rather than the sides of the main body (2). The leaf springs takes up any tolerance between the sleeve (7) and the main body (2) (Col. 4, L. 24-35).

In Martensson, a locking mechanism in the form of an outwardly biased button (14) is provided on a side wall of the main body (2), which button is arranged to fit into a complementary aperture (15) on the side wall of sleeve (7) (see Fig. 3) when the sleeve (7) is moved to the closed (retracted) position. By depressing the release button (14), the sleeve (7) will move automatically to the fully extended position under the action of spring (9). After use, the sleeve (7) is pushed back by the user against the force of the spring (9), to the closed position where the button (14) engages in the aperture (15) and so locks the sleeve (7) in the retracted position (Col. 4, L. 39-50). Movement of the sleeve (7) is arrested at the fully extended position when a lip (16) on the internal top edge of sleeve (7) abuts a flange (17) provided integrally on the main body (2) (Col. 4, L. 56-58; Fig. 5).

There is simply no disclosure in Martensson of the sleeve (7) having first and second runners or of the body (2) having first and second grooves where the first and second runners are

positioned in the first and second grooves respectively to allow the sleeve (7) to slide relative to the body (2) between an open and closed position. Rather, the sleeve (7) of Martensson fits snugly around the main body (2) of the housing (1) (Col. 4, L. 24-25). The sleeve (7) may bear against the main body (2) or leaf springs may be fastened to the sides of the main body (2) so the sleeve (7) bears against the springs (Col. 4, L. 27-35). This is not the same as the first and second runners being **positioned** in the **first and second grooves** respectively to allow the second body portion to slide longitudinally relative to the first body portion between a closed position in which the keypad is concealed and an open position in which the keypad is exposed as recited in claim 1. As evidenced by Fig. 3 of Martensson, the sleeve (7) wraps completely around the main body (2). There is simply no disclosure in Martensson related to first and second runners being **positioned** in the **first and second grooves** respectively, as is claimed in Applicant's invention.

In addition, the button (14) of Martensson is not the same as the "detent" recited in claim 1. A "detent" is a mechanism that temporarily keeps one part in a certain position relative to another and can be released by applying force to one of the parts (Random House Webster's College Dictionary, Copyright 1992, Page 368). The button (14) of Martensson engages the aperture (15) and locks the sleeve (7) in the retracted position (Col. 4, L. 47-50). As can be seen in Fig. 2, the button (14) completely protrudes through the aperture (15) and extends beyond the wall of the sleeve (7) thereby preventing the sleeve (7) from being moved from the closed position regardless of any force applied to the sleeve (7) or the main body (2). The sleeve (7) can only be released by "depressing the release button (14)" (Col. 4, L. 44-

45). Therefore, the button (14) cannot be a **detent** as recited in claim 1.

Col. 4, lines 39-59 of Martensson, relied on by the Examiner, does not disclose or suggest these features. This section of Martensson merely refers to the "locking mechanism", which is an outwardly biased button, discussed above. There is no disclosure here, or anywhere else in Martensson, related to first and second runners being **positioned** in the **first and second grooves** respectively or of a first body portion comprising a first detent located in the first groove, and the second body portion further comprising a first recess in the first runner to hold the second body portion relative to the first body portion when the first recess coincides with the first detent.

Also, the aperture (15) cannot be a recess as recited in claim 1. A recess is defined as an indentation (Random House Webster's College Dictionary, Copyright 1992, Page 1125, Definition 4). The aperture (15) is just that, a hole in the sleeve (7). It is not an indentation in the sleeve, as can be seen in Fig. 2 where the button (14) is shown protruding through the aperture (15). There is simply no disclosure or suggestion of a detent, let alone "a first detent located in the first groove, and the second body portion further comprising a first recess in the first runner to hold the second body portion relative to the first body portion when the first recess coincides with the first detent" as is claimed by Applicant.

Thus, claim 11 is patentable over Martensson. Claim 12 depends from claim 11 and should also be patentable at least by reason of its dependency.

5. Claims 13-18, which ultimately depend from claim 11, are patentable under 35 U.S.C. §103(a) over Martensson because Martensson fails to disclose or suggest all the features of claim 11 for the reasons described above. As such, it would not be obvious to a person skilled in the art to modify the portable cellular radio telephone of Martensson to arrive at what is claimed by Applicant in claim 13-18.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (See MPEP § 2142).

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). (See MPEP § 2142). The Examiner merely states that it would have been obvious to modify Martensson for ease of the user when using the telephone.

This is far from "a convincing line of reasoning" especially when Martensson fails to teach all the claim limitations as described above with respect to claim 11. Because all the limitations of claims 13-18 are not disclosed or suggested in Martensson a *prima facie* case of obviousness has not been established. Therefore, claims 13-18 are patentable over Martensson.

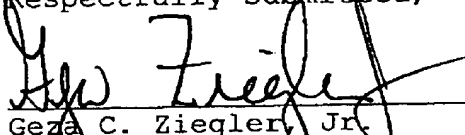
It is respectfully requested that the Examiner provide a convincing line of reasoning why it would be obvious to modify Martensson to arrive at what is claimed in claim 13-18.

6. Claims 31-39 should be allowable because there is simply no disclosure or teaching in Martensson to have a second recess coinciding with the first detent in the open position. The mechanism in Martensson does not rely on any detent or recess in a runner, groove or elsewhere. Thus, these claims are also allowable.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge \$1,420 for a three-month extension of time and the additional claims fee (8 dependent claims) together with payment for any other fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

  
Geza C. Ziegler, Jr.  
Reg. No. 44,004


13 JAN 2006  
Date

Perman & Green, LLP  
425 Post Road  
Fairfield, CT 06824  
(203) 259-1800  
Customer No.: 2512

#### CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being transmitted by facsimile to (571) 273-8300 on the date indicated below, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: 1/13/2006

Signature: 

Geza ZIEGLER Jr  
Person Making Deposit